

## REMARKS

Reconsideration of the subject application is respectfully requested.

Claims 74 through 159 are pending, with Claims 74, 76 through 80, 103, 104, 107 through 109, 124 through 126, 128, 129, 134 through 144, and 154 through 159 being independent.

The Official Action sets forth a restriction requirement and requires election for prosecution on the merits one of the following groups of claims:

Group I:                      Claims 74 through 139 and 144 through 158; and

Group II:                     Claims 140 through 143 and 159.

In response to the Restriction Requirement set forth in the Official Action, Applicants provisionally elect Group I (Claims 74 through 139 and 144 through 158) with traverse, and request reconsideration and withdrawal of the requirement.

Initially, Applicants respectfully submit that Claim 143, which recites a method, should be examined together with Group I. Furthermore, Applicants respectfully submit that:

- (a)      Claims 134 through 139 variously correspond to Claims 1 and 2 of U.S. Patent No. 6,326,280, while Claims 140 through 142 variously correspond to Claims 3 and 4 of that patent, and no restriction was maintained in that patent; and
- (b)      Claims 143 through 158 correspond to Claims 1 through 17 of U.S. Patent No. 6,426,274, while Claim 159 corresponds

to Claim 18 of that patent, and no restriction was maintained in that patent.

In addition, Applicants submit that all of the claims could be searched by one Examiner without undue effort. Applicants also believe that it is not mandatory to make a restriction requirement in every possible situation. Applicants believe that if one Examiner acts on all of the claims of the present application, overall examining time will be less than if multiple Examiners are involved. Applicants also earnestly believe that the examination of all of the claims by one Examiner in the present application will best ensure uniform prosecution quality. Therefore, in the interest of prosecution economy of time and quality for both the Office and Applicants, Applicants respectfully submit that withdrawal of the restriction requirement in this application is appropriate.

The Official Action also indicates that if Applicants elect Group I, then the Election of Species Requirement from the September 17, 2003 Official Action is reiterated, i.e., it is required that Applicants elect one of the following two species for prosecution on the merits:

- |             |  |
|-------------|--|
| Species I:  | “including separating the semiconductor substrate”                       |
| Species II: | “including annealing the anodized substrate in a<br>hydrogen atmosphere” |

with Claims 88 through 90, 105, 114, 115, and 113 being said to “link inventions I and II”. This Requirement is respectfully traversed.

Applicants provisionally elect Species I with traverse, and submit that of the Group I claims, at least Claims 74 through 102, 105 through 123, 127 through 139, 144

through 155, 157, and 158 (all of which recite “separating”) are readable upon the elected species (it will be appreciated that of the foregoing claims, Claims 88 through 91, 105, 106, 114, 115, 127, and 133 recite both “separating” and “annealing”).

However, as discussed in the October 17, 2003 Response to Election of Species Requirement, Applicants respectfully request that the Election of Species Requirement be withdrawn. Applicants respectfully submit that the Election of Species Requirement is not in keeping with prior U.S. Patent and Trademark Office treatment of the matter. The Office has already issued no less than three patents that contain both (a) claims that recite “separating” and (b) claims that recite “annealing”, as shown in the following Table A:

TABLE A

| Patent No. | Claims reciting “separating”, e.g.: | Claims reciting “annealing”, e.g.: |
|------------|-------------------------------------|------------------------------------|
| 6,107,213  | 1, 2, 20                            | 19                                 |
| 6,326,280  | 1, 2, 4                             | 3                                  |
| 6,426,274  | 1, 2, 13, 14, 16-18                 | 15                                 |

Yet no Election of Species Requirement was maintained in those three cases. Applicants have simply copied claims from these patents for purposes of provoking an interference with them. Applicants should not be subject to the prejudice inherent in being accorded treatment respectfully believed to be not in keeping with prior multiple Office decisions. Neither Applicants nor the Office should be put through the trouble and expense entailed in multiple filings and prosecutions. The making of an Election of Species Requirement is not mandatory in all instances, and Applicants respectfully submit it is inappropriate in this

instance. In view of the foregoing, in the interests of prosecution and economy of time, for Applicants, the Office, and the public-at-large, reconsideration and withdrawal of the Election of Species Requirement is respectfully requested.

SUBMISSION OF SWORN TRANSLATIONS OF PRIORITY DOCUMENTS

Applicants have attached hereto sworn translations of the following Japanese Patent Applications, from which the subject application claims priority under 35 U.S.C. § 119, as shown by the following Table B, which also shows the date that the certified copy of each Japanese Patent Application was filed and in which U.S. application it was filed:

TABLE B

| Japanese Patent Application | filing date of Japanese Patent Application | date certified copy of Japanese Patent Application filed & U.S. application in which filed |
|-----------------------------|--|--|
| 6-39389                     | March 10, 1994                             | June 27, 1995 in 08/401,237 filed March 9, 1995  |
| 7-45441                     | March 6, 1995                              | June 27, 1995 in 08/401,237 filed March 9, 1995  |
| 7-260100                    | Oct. 6, 1995                               | December 4, 1996 in 08/729,722 filed October 7, 1996                                       |
| 8-41709                     | Feb. 28, 1996                              | July 14, 1997 in 08/807,604 filed February 27, 1997  |
| 8-264386                    | Oct. 4, 1996                               | July 14, 1997 in 08/807,604 filed February 27, 1997  |

REQUEST FOR INTERVIEW

Applicants respectfully request that the Examiner contact Applicants' undersigned representative to schedule a personal interview to discuss the foregoing and the proposed interference.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in cursive script, reading "Daniel S. Glueck", is written over a horizontal line.

Attorney for Applicants

Daniel S. Glueck

Registration No. 37,838

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3800  
Facsimile: (212) 218-2200  
DSG/dc

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